

Taka-Aki Sato
Serial No.: 10/820,403
Filed: April 8, 2004
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application, the Examiner to whom the subject application is assigned indicated that restriction would be required under 35 U.S.C. §121 to one of the following allegedly distinct inventions:

- Group I. Claims 1-9 and 16, drawn to a method of preparing a protein array;
- Group II. Claims 10-12 and 17-19, drawn to a method of preparing a protein array wherein at least one array element includes an oligonucleotide such as mRNA or DNA; and
- Group III. Claims 13 and 20, drawn to a method of preparing a protein array wherein one of the array element includes a sugar.

In the December 16, 2004 Restriction Requirement, the Examiner alleged the inventions are distinct, each from the other. The Examiner stated that inventions I, II and III are unrelated. The Examiner further stated that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. The Examiner also stated that in the instant case the different inventions are drawn to different methods using structurally different components and steps that result in different array of compounds with different effects and/or functions.

The Examiner also stated that because these inventions are allegedly distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter, and the search required for Group I is not required for Groups II and II, specifically the literature search, restriction for examination purposes as indicated is proper.

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The Examiner advised applicant that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant hereby elects, with traverse, to prosecute the invention of Group I, claims 1-9 and 16, drawn to a method of preparing a protein array.

Applicant, however, respectfully requests that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of Group I (claims 1-9 and 16), Group II (claims 10-12 and 17-19) and Group III (claims 13 and 20) are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subjects disclosed. Each of the claims of Group II is dependent from either claim 1 or claim 16 of Group I. Similarly, each of the claims of Group III is dependent from either claim 1 or claim 16 of Group I. Applicant therefore maintains that the Groups are not independent and restriction is improper.

Applicant maintains that it would not be a serious burden on the Examiner if restriction is not required, because in view of the claim dependencies a search of the prior art for Group I would necessarily identify art for Groups II and III. Applicant

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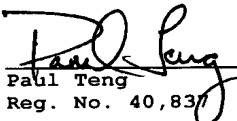
therefore maintains that the search and examination of the claims of Group II and Group III in addition to the claims of Group I would not be a serious burden on the Examiner. Since there is no burden on the Examiner to examine Groups I, II and III of the subject application, the Examiner should examine the inventions of Groups I, II and III on the merits together.

Accordingly, in view of the preceding remarks, applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement.

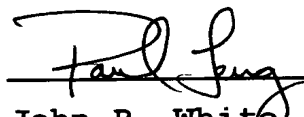
No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


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January 14, 2005
Date



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